

DOCKET NO. BILL01-00005
SERIAL NO. 09/684,762
PATENT

REMARKS

Claims 1-5 and 7-21 were pending in this application.

Claims 1-5 and 7-21 have been rejected.

Claim 1 has been amended as shown above.

Claims 1-5 and 7-21 remain pending in this application.

Reconsideration and full allowance of Claims 1-5 and 7-21 are respectfully requested.

I. NEW MATTER OBJECTION

The Office Action objects to the amendment filed on November 7, 2005 as introducing new matter. In particular, the Office Action asserts that the claim limitations added to Claims 1 and 16 were not supported by the original disclosure.

The Applicants respectfully note that the claim limitations added to Claim 1 are described in the originally filed application at page 26, lines 18-25. The Applicants also respectfully note that the claim limitations added to Claim 16 are described in the originally filed application at page 27, lines 2-5.

Accordingly, the Applicants respectfully request withdrawal of the new matter objection.

II. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Office Action rejects Claims 1-5 and 7-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts that the claim limitations added to Claims 1 and 16 lack written description.

DOCKET NO. BILL01-00005
SERIAL NO. 09/684,762
PATENT

As noted above, these claim limitations are supported by the originally filed application. As a result, the application satisfies the written description requirement. Accordingly, the Applicants respectfully request withdrawal of the § 112, first paragraph rejection.

III. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Office Action rejects Claims 16-20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Determining whether a claim is indefinite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. (*MPEP* § 2173.02; *Credle v. Bond*, 25 F.3d 1566, 1576, 30 U.S.P.Q.2d 1911, 1919 (Fed. Cir. 1994)). The claim is not indefinite if one skilled in the art would have no particular difficulty in determining whether the recited feature has been implemented. (*MPEP* § 2173.02; *In re Warmerdam*, 33 F.3d 1354, 1361, 31 U.S.P.Q.2d 1754, 1759 (Fed. Cir. 1994)).

The Office Action does not establish that one skilled in the art would have difficulty determining whether the recited features in Claim 16 have been implemented. The Office Action also does not establish that one skilled in the art would be unable to understand the bounds of Claim 16 when read in light of the specification. Instead, the Office Action has simply made an assumption that one skilled in the art could not determine the scope of Claim 16. This is inadequate to establish a § 112 rejection under *MPEP* § 2173.02.

Accordingly, the Applicants respectfully request withdrawal of the § 112, second paragraph rejection.

DOCKET NO. BILL01-00005

SERIAL NO. 09/684,762

PATENT

IV. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-3, 8-11, and 14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,052,629 to Leatherman et al. ("*Leatherman*") in view of U.S. Patent No. 6,288,688 to Hughes et al. ("*Hughes*") and U.S. Patent No. 6,446,192 to Narasimhan et al. ("*Narasimhan*"). The Office Action rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Leatherman*, *Hughes*, and *Narasimhan* in further view of U.S. Patent No. 5,890,520 to Johnson, Jr. ("*Johnson*"). The Office Action rejects Claims 4 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Leatherman*, *Hughes*, and *Narasimhan* in further view of U.S. Patent No. 5,554,912 to Thayer et al. ("*Thayer*"). The Office Action rejects Claims 5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over *Leatherman*, *Hughes*, and *Narasimhan* in further view of Official Notice. The Office Action rejects Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Leatherman*, *Hughes*, and *Narasimhan* in further view of U.S. Patent No. 6,783,028 to Ambrose et al. ("*Ambrose*"). The Office Action rejects Claims 16-20 under 35 U.S.C. § 103(a) as being unpatentable over *Leatherman* in view of U.S. Patent No. 6,442,448 to Finley et al. ("*Finley*"), Official Notice ("*Official Notice*"), and U.S. Patent No. 6,014,644 to Erickson ("*Erickson*"). The Office Action rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over *Leatherman* in view of *Finley*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re*

DOCKET NO. BILL01-00005
SERIAL NO. 09/684,762
PATENT

Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicants to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicants are entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicants' disclosure. (MPEP § 2142).

Regarding Claim 1, Claim 1 recites that a "master interface system" is capable of interacting with "one or more external systems" (including a "central office system" that provides "updates" of "advertising information") only when the interaction is "initiated by the master interface system."

DOCKET NO. BILL01-00005
SERIAL NO. 09/684,762
PATENT

The Office Action cites *Narasimhan* as disclosing these elements of Claim 1. *Narasimhan* recites that a “sockets type interface” is used for communication between an equipment processor and a network interface chip. A “client socket” is initiated by a device to connect to a known server, and a “server (or listen) socket” is set up to wait for clients to request a connection on a particular port. (Col. 18, Lines 18-34).

This portion of *Narasimhan* simply describes different types of sockets, one of which waits for connection requests. Nothing in *Narasimhan* describes allowing interaction only when the interaction is initiated by a “master interface system.” In particular, this portion of *Narasimhan* fails to disclose, teach, or suggest a “master interface system” that is capable of “interacting with one or more external systems, including [a] central office system, only when the interaction is initiated by the master interface system” as recited in Claim 1.

Also, the Office Action asserts that the motivation for modifying *Leatherman* and *Hughes* with *Narasimhan* is “to connect the central office system and the master interface system with a reliable data stream.” (Office Action, Page 6, First paragraph). However, nothing in *Narasimhan* recites that reliable data streams are provided only when an interaction is initiated by a master interface system. Rather, *Narasimhan* teaches the use of sockets to provide a reliable data stream. This teaching is unrelated to interaction (e.g. updating) between an external system and a master interface system “only when the interaction is initiated by the master interface system.”

In addition, *Narasimhan* is completely unrelated to fuel dispensing systems and master interface systems that download updates of advertising information for delivery to customers. As a result, *Narasimhan* is non-analogous art and cannot be cited against the claims of this patent

DOCKET NO. BILL01-00005
SERIAL NO. 09/684,762
PATENT

application.

Regarding Claim 16, Claim 16 recites that a “master interface system” is capable of accessing a “central office system” at a “prescribed time” along with “other master interface systems” so that “all master interface systems receive additional information for substantially simultaneous presentation by all master interface systems.”

The Office Action cites *Erickson* as disclosing these elements of Claim 16. The cited portion of *Erickson* recites that a local database 36 may be updated on a “periodic basis” and that a local database maintenance processing block 60 may send a request to a service provider 14 on a “periodic or regular schedule in order to receive any new information.” (*Col. 17, Lines 45-55*).

This portion of *Erickson* simply indicates that a local database is updated periodically and that requests for information are sent periodically or regularly. Nothing in *Erickson* describes a “master interface system” accessing a central office system along with “other master interface systems” so that “all master interface systems receive additional information for substantially simultaneous presentation by all master interface systems” as recited in Claim 16.

Regarding Claim 21, the Office Action does not attempt to establish that the proposed *Leatherman-Finley* combination discloses, teaches, or suggests all elements of Claim 21. For example, the Office Action still does not explain why a person skilled in the art would be motivated to physically attach a “master interface system” to a “fuel dispenser” as recited in Claim 21.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claims 1, 16, and 21 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejections and full allowance of Claims 1-5 and 7-21.

DOCKET NO. BILL01-00005
SERIAL NO. 09/684,762
PATENT

V. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

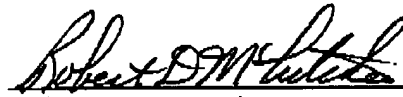
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: rmccutcheon@davismunck.com